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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,232	02/26/2004	Frank T. Hartley	ION-09	9193
26686	7590	03/13/2006	EXAMINER	
CARL A. KUKKONEN, III			KALAFUT, STEPHEN J	
525 Seabright Lane				
Solana Beach, CA 92075			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/786,232	HARTLEY, FRANK T.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephen J. Kalafut	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-34 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. ____ .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are confusing because they are drawn to a fuel cell, or method of making a fuel cell, but instead of reciting fuel cell components (anode, cathode, electrolyte), recite the components of a device for ionizing gases. Thus, whether a fuel cell, as the term is normally understood, needs to be present in order for the claims to be met cannot be determined. The present disclosure shows a system including a gas ionizer (705) and a fuel cell (710) used in combination (figure 7). Regarding claim 17, a proton exchange membrane functioning as cathode would not make sense in the fuel cell art, since this type of membrane serves to allow protons to pass through itself, while a cathode is the place where protons react with oxygen and electrons to form water. In claim 18, there is no antecedent for “said protein exchange membrane” (“protein” rather than “proton”). The term “thin” in claim 19 is a relative term that renders the claim indefinite. The term “thin” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 20-32 depend from claim 19 and would likewise be indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 11, 12, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Spindt (US 4,926,056).

These claims are interpreted as not requiring a fuel cell, as normally understood, to be present. Spindt discloses a microelectronic field ionizer that includes a silicon substrate (21) between two metal layers (24, 33), through all of which tapered holes are formed (figures 4e through 4h). The substrate would correspond to the present “ionization membrane”. The metals layers would correspond to the present anode (24) and cathode (33). Recitations of how the ionization device operates are not given weight, since these claims are drawn to an article. Recitations relating the separation of the electrodes to the size of a “mean free path” cannot be given weight, because the gas to be ionized is not part of the device. Thus, to the extent that these claims are understood, they would be anticipated by Spindt.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-57 of U.S. Patent No. 6,642,526 in view of Schumacher *et al.* (US 5,075,594). In Patent No. 6,642,526, applicant claims an ionizing device including two electrodes and an insulating element, which would be a membrane. The device includes at least one opening (claim 1) or hole (claim 13). The distance between the two electrodes may be less than the mean free path of the material being ionized (claim 13). The claims also recite methods of forming the ionizing device (claims 22-45). The present claims differ from the patented claims by reciting a cathode that receives the ions generated by the ionizing device. Schumacher *et al.* disclose a thermionic cathode (36) which generates heat resulting from being bombarded by ions (column 3, lines 35-40). Because this would provide the ions generated by the device claimed in Patent No. 6,642,526 with a suitable use, it would be obvious to use the thermionic cathode of Schumacher *et al.* therewith.

The disclosure is objected to because of the following informalities: The numeral 820 in figure 5 and on page 9 is used to indicate two different items. Appropriate correction is required.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Felter (US 6,452,167) and Stinnett (US 4,447,761) disclose ion-generating devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Kalafut whose telephone number is 571-272-1286. The examiner can normally be reached on Mon-Fri 8:00 am-4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sjk



PRIMARY EXAMINER  
GROUP 1700